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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/743,455
Filing Date: December 23, 2003
Appellant(s): DE RIGAL ET AL.

William P. Berridge
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/07/2008 appealing from the Office action mailed 01/23/2008.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The amendment after final rejection filed on 11/07/2008 has been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

French Patent 2 178 441 (full English language translation)

MacFarlane et al (USP 5,313,267).

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Obviousness Rejection

Claims 1-15 and 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over French Patent 2 178 441 (full English language translation) in view of MacFarlane et al (USP 5,313,267).

The primary reference teaches a device enabling one to select the proper makeup hue for application to a given part of the face so as to provide the optimum overall aesthetic effect. See, e.g., the first and last 3 paragraphs of page 2 of the translation. Where the subject had "dark" skin (which would include relatively darker areas on the face), it would be reasonably expected to involve selecting cosmetic shades having a lightening effect.

The primary reference differs from the instant claims insofar as it does not specify, *ipsissima verba*, selection of cosmetics based specifically on skin color (necessary to arrive at the particular lightness values recited by instant claims 1-15 and 34-38).

The secondary reference teaches methods for personal color characterization using skin color as the exclusive determining factor. See column 2, lines 25-68. By varying the amount and type of coloring agent present in various personal accessories,

including makeup foundation, the color of the accessories can be adjusted for optimal compatibility with skin color. See column 4, lines 34-48; see also column 16, lines 34-68.

The secondary reference differs from the instant claims insofar as it does not specify selection based on differences in shading within different parts of the face (necessary to arrive at the particular levels of homogenization and covering power recited by instant claims 1-15 and 34-38).

It would have been obvious to have formulated cosmetics having an optimal combination of physical characteristics (homogenization power, covering power, etc.) for a given shade selected by the device of the primary reference, based on color characterization using skin color as the exclusive determining factor as taught by the secondary reference.

(10) Response to Argument

Applicant first argued that the prior art does not fairly suggest, teach or disclose the instantly claimed subject matter, particularly the newly recited reflectance values and reflective particles.

In response, Examiner asserted the use of such particles appear to be conventional in the cosmetic art, however, as acknowledged at pages 16 et seq. of the instant specification; moreover, the reflectance value of 550 to 675 nm appears to represent nothing more than orange coloration: see page 13, lines 15- 18.

Further, Examiner asserted where functional parameters such as the instant hue angle, saturation, covering values, etc. are recited and the prior art discloses otherwise

similar prior art, the burden is on applicant to demonstrate the unobviousness of those parameters. See In re Greenfield, 197 USPQ 227 (C.C.P.A. 1978). In that case, certain paint additives were functionally characterized as being unexpectedly stable in the presence of formaldehyde. At page 229 of the decision, the court unambiguously stated that, despite the fact that the rejection was one of obviousness and not anticipation, the burden was nevertheless on applicant to provide factual verification of the alleged functional property:

Appellants argue that the prima facie case is rebutted by a showing that, under the claimed pH conditions, 3-isothiazolones normally decompose, but that they do not do so when formaldehyde is added to the composition; that is, the presence of formaldehyde in the paint compositions have the unexpected property of stabilizing the 3-isothiazolone. However, the validity of the argument depends on whether it has been demonstrated the Claimed 3-isothiazolones normally decompose under the claimed conditions... We are inclined to agree with appellants that, if the record establishes that formaldehyde stabilizes the claimed 3-isothiazolones under the claimed conditions, the prima facie case would be rebutted... Appellants have submitted no objective evidence to demonstrate the existence of a degradation problem of 3-isothiazolones and rely solely on the specification.

Applicants now assert Bourjois and MacFarlane fail to disclose or establish any reason to provide a foundation cosmetic composition comprising the claimed combination components and properties of independent claim 1. Further, Applicants assert that Examiner failed to establish a *prima facie* case of obviousness.

In response, Examiner notes instant claim 1 is directed to foundation cosmetic compositions, which comprises a physiologically acceptable medium, at least one coloring agent having a yellow or orange coloration, and having a significant reflectance in the range from 550 to 675 nm and reflective particles. The rest of the claim 1 appears to be directed to functional language which provides various properties of the foundation cosmetic composition when applied to a contrast card. Instant claim 2 adds a

cosmetically acceptable medium. Claims 3-9, 14-15, and 34-38 are then directed to further functional language which provides properties of the composition when applied to a contrast card. Claims 10-13 are directed to methods of lightening dark skin.

The claims are directed to a composition (claims 1-2), where the only components recited appear to be the presence of a physiological/cosmetic acceptable medium, yellow or orange coloration, and reflective particles. MacFarlane was cited to disclose the use of yellow and orange colors in cosmetic compositions, which have reflective properties. Bourjois teaches it would be obvious to vary colorants to "lighten" a darker area of the face, thus providing motivation to vary the colorant ranges depending on the part of the face to lighten. Where variation is suggested in the prior art, it would be obvious to one of ordinary skill to adjust the same for various applications, making the instantly claimed obvious as the skilled artisan modifies the foundation for various facial colors. As such, a *prima facie* showing has been made to select varying degrees of colorant which would read on the instantly claimed ranges and the method of use would be obvious to one of ordinary skill given the purpose of the cosmetic compositions.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Benjamin Packard/

Conferees:

/Fredrick Krass/

Supervisory Patent Examiner

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/Jean Witz/

Quality Assurance Specialist

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